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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/659,878	JOSHI ET AL.	
	Examiner	Art Unit	
	ROBERT MOSSER	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23rd July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-12,14-23 and 25-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-12,14-23 and 25-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant Admitted Prior Art

The Examiner presented Official notice in the office action dated March 28th, 2007 that the utilization of identical gaming machines in a pari-mutuel jackpot system such as taught by Celona is exceptionally old and well known in the art. This notice was not challenged in the subsequent reply by Applicant, accordingly this feature is considered Applicant admitted prior art.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim **1-2,** and **4-11** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under *Bilski*, "[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." To avoid preemption the Federal Circuit emphasized that "the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility;" that "the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity;" and that the transformation "must be central to the purpose of the claimed process." In the instant application the method claims do not set forth a tie to a particular machine or apparatus beyond nominal recitations of a slot machine

in claims 7 and 11 which do not impart a change of slot machine into a different state or thing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The independent claims as presented set forth a first progressive jackpot and a second multi-level progressive jackpot awarded to a player resultant of a first and second game outcome and wherein the first and second jackpot have at least the respective value of a first reserve amount and a second reserve amount defined as greater then the first amount and jackpot accrues at a first and second accrual rate respectively

Claim **1-2, 5-8, 11-12, 15-23,** and **26-27** rejected under 35 U.S.C. 103(a) as being unpatentable over Celona (US 5,564,700) in view of Green (US 5,538,252) in yet further view of Cannon (US 5,344,144).

Claims **1, 8, 12**, and **26**: Celona teaches a method of playing a wagering game including a base game with a randomly selected game outcome (*Celona* Col 4:28-34) and allowing the player to present a base wager and in addition thereto an additional wager amount in the form of a max bet (*Celona* Col 3:52-4:15). Responsive to the presence of a max wager the player is eligible to receive a special progressive jackpot payout consisting of first payout/award equal to half of a progressive jackpot and a second payout/award equal to a percentage of the remaining portion of the jackpot that is in turn distributed among the remaining eligible players who did not receive the first payout upon awarding of the jackpot prize (*Celona* Col 3:58-62 & 3:44-47). Celona however is silent regarding explicitly teaching a base wager and a side wager as two distinct wagers however, in a related progressive wagering system, Greene teaches the separation of a basic wager and side wager for participation in a multi-level progressive environment (*Green* Col 12:20-13:51). Green further teaches that the multi-level progressive jackpots are presented to the player reflective of achieving a joker outcome in a single game play (Green Col 12:28-13:48). As the base game payout and the jackpot wagers are distinct, this is understood to additionally convey that the player receives a first respective award amount for achieving a winning hand in the base game and a secondary payout responsive to the placement of a press wager. It would have been obvious to one of ordinary skill in the art at the time of invention to have separated the game wager and side wager into two distinct wagering events in the game of Celona as taught by Green in order to allow a player to place a maximum base game wager without requiring participation in the progressive payout and alternatively allow the

player to participate in the multilevel progressive payout without requiring a maximum base game wager.

The combination of Celona/Green as presented above is silent regarding the funding the jackpot comprising a first and second reserve amount and in addition thereto comprising and contributing a first and second percentage to each respective jackpot in a manner such that the second reserve amount is greater then the first reserve amount and reflective therewith the second contribution percentage is greater then the first contribution percentage. With reflect to these features however Cannon 144' teaches the utilization of jackpot pools of differing reserve amounts as well as different contribution rates associated with the respective jackpot pools (Cannon 144' Figure 4, Col 4:19-48, 6:49-68). Given the teaching Cannon 144' teaches pools and contribution rates of different amounts one of these respective amount must by definition be greater the remainder amount. While this inherent teaching provides for the separation based on a first accrual rate and reserve amount according to magnitude it does not necessarily indicate separation would be reflective of the respective magnitudes in combination. Accordingly the association of the that the greater/lesser reserve amounts and the respective greater/lesser contribution rates is understood as being obvious to one of ordinary skill in the art at the time of invention for representing an instance one skilled in the art is choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success (*KSR*

International Co. v. Teleflex Inc). In this instance the finite number of solutions would be the particular association between the two different accrual rates and two different reserve amounts yielding four possible combinations of these known elements.

Claims **2,** and **27**: In addition to the above, the combination Celona/Green/Cannon teaches the incorporation of a third payout based on the randomly selected game outcome as a conventional game payout (*Celona* Col 4:35-40), a local jackpot payout (*Celona* Col 4:40-42), however is arguably silent regarding the third payout being of a "progressive" type. Celona/Green/Cannon further teach the presentation a multilevel progressive jackpot (*Green* Col 12:20-13:51). As provided it would have been obvious to one of ordinary skill in the art at the time of invention to have transformed the local jackpot of Celona into a local progressive jackpot in order to ensure that the local jackpot increases with play.

Claims **5-7,** and **16-18**: In addition to the above, the combination of Celona/Green/Cannon teaches that the game machine may be of a slot type and a poker type wherein both machine types are understood to inherently contain a plurality of symbols (e.g. cards and slot machine wheel symbols) and further that a slot machine game inherently includes slot machine reel symbols while a poker game inherently includes card symbols for a deck of playing cards (*Celona* Col 1:17-20, 6:28-33).

Claim **11**: In further addition to the above, the combination of Celona/Green/Cannon teaches an awarding step cited in the redress of at least claim 1 above is performed by the controller located in the gaming terminal through the dispensing of an award amount (*Celona* Col 4:48-56, Elm 342 Col 6:45-50).

Claim **15**: In further addition to the above, the combination of Celona/Green/Cannon teaches the use of a button for initiating play of the gaming machine upon the deposit of a wager (*Celona* Col 4: 16-20, 4:29-34). As the player must activate the button in order to commence play the side wager device of Celona is understood to incorporate a button.

Claim **19**: In further addition to the above, the combination of Celona/Green/Cannon teaches the incorporation of a plurality of gaming terminals wherein each terminal incorporates the side wager input device (*Celona* Figure 1).

Claims **20-22**: In further addition to the above, the combination of Celona/Green/Cannon teaches the incorporation of signage displaying the special jackpot payout, wherein the signage is located above, and coupled to the plurality of gaming device through a signage controller and terminal controllers. The signage and signage controller are further configured to receive a signal that at least one of a plurality of gaming machines is eligible to receive the special jackpot payout (*Celona* Elm 308, 338 Col 6:51-7:51, 8:42-50, 9:1-3, Figure 3).

Claim **23**: The combination of Celona/Green/Cannon teaches the claimed invention as set forth above and including multiple gaming machines (Figures 1-3) however, is silent regarding explicitly teaching that the plurality of gaming machine utilized are identical gaming machines. It is Applicant admitted prior art that the utilization of identical gaming machines in a pari-mutuel jackpot system such as taught by Celona is exceptionally old and well known in the art. It therefore would have been prima facie obvious to have utilized the system of Celona with a plurality of identical gaming

machine in order to promote the use of a particular gaming machine over comparative non-pari-mutuel jackpot systems.

Claims **4, 9-10, 14,** and **25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Celona (US 5,564,700) in view of Green (US 5,538,252) in further view of Cannon (US 5,344,144) in yet further view of Cannon (US 6,800,026).

Claims **4, 14,** and **25**: The combination of Celona/Green/Cannon teaches the claimed invention as set forth above however, is silent regarding award a bonus game as a special payout. In a related invention Cannon teaches awarding bonus games conditioned on placement of a max bet (*Cannon* Col 8:62-66). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the bonus game as a prize outcome in the game of Celona in order to provide an award outcome that would allow a plurality of participants to interact in a competitive environment (*Cannon* Col 2:41-44).

Claim **9-10**: The combination of Celona/Green/Cannon teaches the claimed invention as set forth above however is silent regarding slot machines including a plurality of paylines and requiring all of these pay lines to be utilized by the player to qualify for a bonus round, however the reference Cannon teaches this feature (*Cannon* Col 8:62-66). It would have been obvious to one of ordinary skill in the art to have utilized slot machines with a plurality of paylines and requiring all of these pay lines to be utilized by the player to qualify for a bonus round to increase the size of the maximum wager while

additionally increasing the player's ability to achieve a positive outcome in the base game.

Response to Arguments

Due to the recent decision of Bilski, this action is non-final as the pending method claims have necessitated the inclusion of new rejections under USC 101.

Applicant's arguments filed July 23rd, 2008 have been fully considered but they are not persuasive.

On page 9 of the applicant's arguments the applicant proposes that one could not fairly discern the mechanics of the award of Green or the specifics of the multi-level jackpot disclosed by the same. Green however does state that the multi-level jackpot serves as a multiple based on wager of an award amount (Green Col 12:28-52). Following the above challenge the applicant proposes that the prior art of Green does not provide for multiple separate jackpot pools. This however is not point for which Green or Celona is relied upon for teaching. Specifically the prior art of Celona and the prior art of Green both individually teach the presence of jackpot pools which in combination teach the presence of at least two jackpot pools.

On page 9 of the Applicant's remarks the applicant further argues that the prior art of Green teaches a game outcome dependent on multiple game rounds rather then a singular game round. While Green does teach an embodiment of the invention dependent of the outcome of multiple rounds of play, Green additionally teaches an embodiment of the invention dependent on a singular round of play as incorporated in the rejections as presented above.

On pages 9 through 10 the applicant argues a proposed destructive combination between Celona, Green, and Cannon 144' seemly based on the bodily incorporation of the references. However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714